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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,637	09/22/2000	G. Victor Guyan	07752.0019	8161

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,637

Applicant(s)

GUYAN ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 10/27/03. Claims 1-33 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al (5,930,759) in view of Walker et al (6,119,093).

(A) As per claim 1, Moore discloses a method for capture, evaluation and fulfillment of line item level data, the method comprising steps performed by a data processing system (Col.3, lines 17-51), of:

capturing at least one line item data in an insurance host server (Col.6, lines 19-45);

evaluating the line item data during the processing of an insurance claim (Col.5, lines 41-67; Col.17, lines 49-67 to Col.18, line 42). Moore does not explicitly disclose fulfilling the placement of at least one order based on the evaluation of the line item data.

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However, this feature is known in the art, as evidenced by Walker. In particular, Walker suggests fulfilling the placement of at least one order based on the evaluation of the line item data (See Walker, Col.1, lines 42-67 to Col.2, line 37; Col.9, lines 32-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Walker within the system of Moore with the motivation of providing a wide area network communications, such as on the Internet, may be advantageously used by an individual to make a pledge of an unused credit line as collateral for an investment (in particular, the purchase of a share of an insurance policy in syndication) (See Walker, Col.2, lines 45-49).

(B) As per claim 2, Moore discloses the method wherein the step of capturing comprises the steps of:

receiving claim identification information from a claimant, said claim identification information comprising, at least, one line level (Col.4, lines 43-67 to Col.5, lines 51; Col.8, lines 11-43);

storing the line item level data in the insurance host server (Col.6, lines 19-45).

Moore does not explicitly disclose providing a client with an item tree of line item level data based on the line level and aggregating line item level data collected from the claimant.

However, this feature is known in the art, as evidenced by Walker. In particular, Walker suggests providing a client with an item tree of line item level data based on the

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line level and aggregating line item level data collected from the claimant (See Walker, Col.1, lines 42-67 to Col.2, line 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Walker within the system of Moore with the motivation of providing a wide area network communications, such as on the Internet, may be advantageously used by an individual to make a pledge of an unused credit line as collateral for an investment (in particular, the purchase of a share of an insurance policy in syndication) (See Walker, Col.2, lines 45-49).

(C) As per claim 3, Moore discloses the method wherein the step of evaluating the line item data comprises the steps of

displaying at least one line item from the insurance host server (Col.9, lines 33-67 to Col.10, line 63); receiving a selection of at least one line item from a claim handler (Col.7, lines 1-67; Col.8, lines 3-67); and

receiving authorization from the claim handler to execute payment of the selected line item, wherein said authorization is for a payment in a form comprising a direct payment, vendor transfer, line item payment, or preauthorized payment (Col.5, lines 10-51).

(D) As per claim 4, Walker discloses the method wherein the step of fulfilling comprises the steps of:

maintaining a vendor database on the insurance host server (Col.4, lines 47-67 to Col.5, line 64);

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placing at least one order for at least one line item from the insurance host server to a vendor (Col.4, lines 47-67 to Col.5, line 64); and
tracking the order on the insurance host server (Col.4, lines 47-67 to Col.5, line 64).

(E) As per claim 5, Walker discloses the method wherein the step of maintaining a vendor database further comprises the step of entering vendor information in the vendor database (Col.6, lines 5-67).

(F) As per claim 6, Walker discloses the method wherein the step of maintaining a vendor database further comprises the step of editing vendor information in the vendor database (Col.5, lines 9-67).

(G) As per claim 7, Walker discloses the method wherein the step of maintaining a vendor database further comprises the step of upgrading a vendor to a preferred vendor in the vendor database (Col.5, lines 29-67 to Col.6, lines 5-67).

(H) As per claim 8, Walker discloses the method wherein the step of placing at least one order further comprises the step of faxing an order to a vendor (Col.5, lines 9-67).

(I) As per claim 9, Walker discloses the method wherein the step of placing at least one order further comprises the step of emailing an order to a vendor (Col.7, lines 1-58).

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(J) As per claim 10, Walker discloses the method wherein the step of placing at least one order further comprises the step of placing an order on a web server for vendor access (Col.9, lines 31-67 to Col.10, line 67).

(K) As per claim 11, Walker discloses the method wherein the step of placing at least one order further comprises the step of placing an order with a vendor by electronic data interchange (Col.9, lines 31-67 to Col.10, line 67).

(L) As per claim 12, Moore discloses a system for capturing line item data (Col.3, lines 17-51, comprising: a processor for executing programs (Col.4, lines 43-67 to Col.5, line 51); and a memory for storing a program executable by the processor, the stored program including instructions for (i) capturing at least one line item data in an insurance host server (Col.6, lines 19-67; Col.9, lines 1-61); (ii) evaluating the line item data during the processing of an insurance claim (Col.3, lines 17-51; Col.17, lines 49-67 to Col.18, line 42).

Moore does not explicitly disclose fulfilling the placement of at least one order based on the evaluation of the line item data.

However, this feature is known in the art, as evidenced by Walker. In particular, Walker suggests fulfilling the placement of at least one order based on the evaluation of the line item data (See Walker, Col.1, lines 42-67 to Col.2, line 37; Col.9, lines 32-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Walker within the system of Moore with the

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motivation of providing a wide area network communications, such as on the Internet, may be advantageously used by an individual to make a pledge of an unused credit line as collateral for an investment (in particular, the purchase of a share of an insurance policy in syndication) (See Walker, Col.2, lines 45-49).

(M) Claim 23 differs from claim 1 and 12 by reciting a computer readable medium containing instructions for controlling a computer system to perform a method for capturing, evaluating, and fulfilling line item data, the method comprising:

As per this limitation Moore discloses capturing at least one line item data in an insurance host server (Col.6, lines 19-45);

evaluating the line item data (Col.5, lines 41-67) and Walker discloses fulfilling the placement of at least one order based on the evaluation of the line item data (See Walker, Col.1, lines 42-67 to Col.2, line 37; Col.9, lines 32-67).

Thus, it is readily apparent that these prior art systems utilize a computer readable medium containing instructions for controlling to perform their specific function.

The remainder of claim 23 is rejected for the same reason given above for claims 1 and 12, and incorporated herein.

(N) Claims 13-22 and 24-33 recite the underlying process steps of the elements of claims 2-11, respectively. As the various elements of claims 2-11 and have been shown to be either disclosed by or obvious in view of the collective teachings of Moore and Walker, it is apparent that the apparatus disclosed by the applied prior art performs the

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recited underlying functions. As such, the limitations recited in claims 13-22 and 24-33 are rejected for the same reasons given above for method claims 13-22 and 24-33, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed on 10/27/03 regarding claims 1, 2, 12, 13, 23 and 24 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/27/03.

(A) At pages 7-9, of the 10/27/03 response, Applicant's makes the following arguments:

(1) Neither the cited references, alone or in combination, discloses or suggests evaluating line item data during the processing of an insurance claim.

(2) Moore and Walker fail to disclose or suggest evaluating line item data during the processing of an insurance claim.

(B) With respect to Applicant's first and second arguments, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has

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presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 7). Note, for example, the motivations explicitly stated at the first full paragraph of page 2 and 3 of the previous Office Action. Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

With respect to the feature of "evaluation line item data during the processing of an insurance claim," Applicant fails to properly consider Col.1, lines 42-67 to Col.2, line 37; Col.9, lines 32-67 of the Walker reference.

In addition, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, Applicant's argument is not persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches computerized system and method for work management.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
January 10, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600